REMARKS

Claims 64-70 and 72-85 are pending in the application. Claims 64-70, 72-74, 78, and 80-85 have been amended. Claims 86-101 have been added. Therefore, claims 64-70 and 72-101 are now pending in this application.

Support for the amendments to the claims and newly added claims can be found throughout the application, including, but not limited to, the following figures and locations: Figs. 1-3 and pages 1-7. More detailed exemplary support for independent claim 43 is provided below (although support is not necessarily limited to what is indicated):

Claim 43 Element	Exemplary support
a processor; and a memory;	Fig. 1 (element 30); p. 5, lines 15-34.
wherein the computer system is configured to couple to an emulator configured to emulate an integrated circuit designed to communicate bidirectionally with a computer peripheral device;	Fig. 1 (elements 12, 22, and 30); Fig. 2; p. 1, lines 10-28; p. 2, lines 18-24; p. 6, line 33 to p. 7, line 1.
wherein the memory has computer instructions stored thereon that are executable to cause the computer system to:	Fig. 1; Fig. 3; p. 6, lines 22-32.
receive one or more digital data packets at a first transmission rate from the computer peripheral device; store the digital data packets in a memory buffer;	P. 2, lines 18-21 to p. 3, line 7.
retrieve the digital data packets from the memory buffer; and	Fig. 3; p. 3, lines 3-7 and 26-28; p. 7, lines 3-17.
send data contained in the received digital data packets to the emulator at a second transmission rate over a computer peripheral interface coupled to the computer system, wherein the second transmission rate is slower than the first transmission rate.	Fig. 1; fig. 2; p. 2, line 25 to p. 3, line 7; p. 3, lines 16-22.

Application Data Sheet

Applicant submits herewith an Application Data Sheet claiming the benefit of provisional U.S. Application No. 60/193,169, to which the present application is entitled. According to the MPEP:

> If an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaration or

the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to correct the claim *if the information concerning the claim was recognized by the Office as shown by its inclusion on the filing receipt.*

MPEP 201.11(III)(D) (emphasis added). Here, a declaration claiming priority to the '169 provisional was filed on November 19, 2001, the filing date of the present application. The relevant time period set forth in 37 CFR 1.78(a) is thus met in this case because. *See* 37 CFR 1.78(a)(5)(ii). Further, **the Patent Office issued a filing receipt** that indicated the Patent Office recognized a claim to the "benefit of 60/193,169 [with a date of] 03/28/2000." Filing Receipt of June 13, 2002. Therefore, in accordance with 37 CFR 1.78(a)(5)(iii), Applicant claims the benefit of the '169 provisional application in submitting the attached Application Data Sheet.

Rejections Under Section 103

All independent claims stand rejected under 35 U.S.C. 103(a) as being obvious over the Applicant's allegedly admitted prior art (portions of the Background section of the specification) in view of Evans et al. (U.S. Pat. No. 6,279,146) and Gagne (U.S. Patent No. 5,303,347). *See* Final Office Action at 3-9 (note that although Gagne is not mentioned in the bolded summary of the rejections near the top of page 3, Gagne is discussed in the body of the rejections). Applicant disagrees with these rejections, and has amended the claims.

As an initial matter, Applicant notes that in relying on alleged prior art admissions by the Applican, an "[e]xaminer must set forth the underlying facts and reasoning leading to the conclusion that a disclosure or statement constitutes a prior-art admission." *Ex parte Shirley*, Appeal No. 2009-2352 at 22 (BPAI 2009). For example, it is inappropriate to "conclude that every single statement contained within a section of a Specification titled 'Prior Art,' 'Background of the Invention,' or the like, constitutes a prior art admission merely by virtue of the statement's placement in such a section." *See id.* at 25. Thus, Applicant submits that merely because the present specification has a section title "Background of the Invention" on pages 1-2, it cannot be assumed that any statement in this section necessarily constitutes admitted prior art, and instead, the Examiner must—at a minimum—explain his reasoning. *See id.* at 22.

The Background section of the specification recites that "[w]hen an integrated circuit that has a computer network interface is simulated or emulated, network activities are usually simulated or emulated at the speed of the circuit emulator or the circuit simulation." Specification at 1, lines

21-23. The circuit emulator "typically operates at a slower speed than the network." *Id.* at p. 2, lines 7-8. The Background thus further recites that "another conventional technique for connecting a circuit emulator to [a] network requires slowing down the network, receiving signals from the slowed network and translating the signals...." *Id.* at p. 2, lines 4-6.

Evans is directed to "performing developmental testing on a target system electronic design," Evans at col. 1, lines 15-16, and notes that a "first step in typical current design verification methodology is to divide a design into various functional blocks, and then to design and verify each block separately." *Id.* at col. 1, lines 20-23. Evans teaches a "host workstation 114" connected to a "verification engine 60." *Id.* at Fig. 2 and col. 8, lines 24-25. The host workstation 114 is also connected to a "gui host device 119" and a "simulation host computer 118." *See id.*

Even assuming *arguendo* that the cited portions of the Background constitute admitted prior art (APA) and that there would be a motivation to combine the APA with Evans (which Applicant does not concede), such a proposed combination fails to teach or suggest, as recited in amended claim 64, "a computer system" "receiv[ing] one or more digital data packets at a first transmission rate from [a] computer peripheral device," and "send[ing] data contained in the received digital data packets to [an] emulator at a second transmission rate <u>over a computer peripheral interface coupled to the computer system</u>, wherein the second transmission rate is slower than the first transmission rate," and wherein the emulator is "configured to emulate a design of an integrated circuit designed to communicate bidirectionally with [the] computer peripheral device."

The Examiner admits that the Background of the present specification fails to teach, relative to the previous version of claim 64, "buffer[ing] the data packets" and "send[ing] data contained in the buffered data packets to the emulator at a second transmission rate, wherein the second transmission rate is slower than the first transmission rate." The Examiner must thus turn to Evans to provide support for these missing claim elements. Evans, however, fails to remedy the shortcomings of the alleged APA.

Although Evans's host workstation 114 is compared by the Examiner to the "system" of previous claim 64, the Examiner suggests that Evans teaches data being received at host workstation 114 from simulation host computer 118 at a first, <u>slower</u> rate, and then betransmitted from host workstation 114 to verification engine 60 at a second, <u>faster</u> data rate. *See* Final Office Action at 4 (stating that Evans teaches that "the first speed is slower than the second speed.") Thus, according to the Examiner's theory, the connection between Evans's host

workstation 114 and Evans's verification engine 60 (equated with the "emulator" of previous claim 64) apparently operates at a *faster* rate than the connection between host workstation 114 and the simulation host 118. *See* Final Office Action at 4 (stating that "the frequency of communication between the emulator and the computer 114 is faster than that of communication between the simulation computer 118 and the computer 114.") The Examiner then states that it "would have been obvious for one of ordinary skill in the art to use the same system connection[s] to implement data transfer to have the second speed [i.e., the speed between Evans's verification engine 60 and host computer 114] [be] slower than the first speed." Final Office Action at 4, emphasis added. In other words, the Examiner concludes that the opposite approach to his working theory of Evans (reversing the alleged relative speeds of transfer) would have been "obvious" to one of ordinary skill in the art, yet the Examiner provides no further reasoning as to why this would be the case. *See id.*[1] The Examiner's rejection thus fails to show that the proposed combination of the alleged APA and Evans teaches or suggests, as recited by the current version of claim 64, "a computer system" "receiv[ing] one or more digital data packets at a first transmission rate from [a] computer peripheral device," and "send[ing] data contained in the received digital data packets to [an] emulator at a second transmission rate over a computer peripheral interface coupled to the computer system, wherein the second transmission rate is slower than the first transmission rate," and wherein the emulator is "configured to emulate a design of an integrated circuit designed to communicate bidirectionally with [the] computer peripheral device."

Gagne fails to remedy the shortcomings of the alleged APA and Evans. Gagne is primarily concerned with "a way of directing received packets to different types of buffers based on a characteristic of the received packet." See Gagne at col. 1, lines 60-62 and at Abstract. Gagne does not teach or suggest anything in regard to the above-mentioned elements of claim 64 that would cure the defects of Evans (nor does the Examiner cite Gagne for such support relative to previous claim 64). *See* Final Office Action at 4-5.

For at least the reasons above, Applicant submits that the proposed combination of the alleged APA, Evans, and Gagne fails to teach each and every limitation of claim 64. Applicant respectfully requests withdrawal of the § 103 rejections of claim 64 and its dependent claims.

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[1] Applicant does not necessarily agree with the Examiner's contentions about what is taught or suggested by the alleged APA and/or Evans.

For at least similar reasons to those above, Applicant also respectfully requests withdrawal of the § 103 rejections of claims 73, 81, and their respective dependents.

Newly added claims 86-101 are also patentably distinct from the cited art for reasons at least similar to those cited above in support of claim 64. Claim 86 recites, for example, "receiving digital data from a circuit emulator at a program running on at least one processor of a computer, wherein the digital data is received at a first transmission rate, and wherein the circuit emulator is configured to emulate an integrated circuit that is designed to communicate bidirectionally with a computer peripheral device." Claim 86 further recites "the program transmitting the retrieved data to the computer peripheral device at a second transmission rate over a computer peripheral interface coupled to the computer, wherein the first transmission rate is slower than the second transmission rate." Thus, the proposed combination of the cited art fails to teach or suggest claim 86's limitations regarding "transmission rate[s]" involving "digital data" and "an integrated circuit that is designed to communicate bidirectionally with a computer peripheral device." Applicant respectfully submits that claim 86 and its dependent claims are patentably distinct over the cited art, and submits that for at least similar reasons, claims 92, 97, and their respective dependent claims are also patentably distinct.

CONCLUSION

In light of the foregoing amendments and remarks, Applicant submits that all pending claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. If a phone interview would speed allowance of any pending claims, such is requested at the Examiner's convenience.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant hereby petitions for such extensions. No fees are believed due as a result of the present amendments, but if any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505\6057-16302.

Respectfully submitted,

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